

REMARKS

Summary of the Office Action

Claims 1-2 and 4-8 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement.

Claims 1-2 and 4-8 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hayashi (U.S. Pat. Pub. No. 2002/0013531) (hereinafter "Hayashi") in view of Sekiguchi (U.S. Patent No. 4,821,117) (hereinafter "Sekiguchi").

Summary of the Response to the Office Action

Applicants have newly-amended independent claim 1 to differently describe embodiments of the disclosure of the instant application and/or to improve the form of the claims. Accordingly, claims 1-2 and 4-8 remain currently pending and under consideration.

Rejection under 35 U.S.C. § 112, First Paragraph

Claims 1-2 and 4-8 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Independent claim 1 of the instant application has been newly-amended to describe a lymph node detecting apparatus in which the previously-recited, "... is obtained in a single image acquisition" is amended as "... is obtained as a single image."

Applicants respectfully submit that for the above feature, as clearly described in paragraph [0038] of the originally filed specification, optical filter 3, "which selectively transmits fluorescence image 11 from among the light from living body observation portion 20,

may transmit, at a predetermined light intensity, a reflection image from living body observation portion 20 illuminated by excitation light 10," and in this case, "an observation image, such as shown in FIG. 4(c), in which a fluorescence picture image, such as shown in FIG. 4(a) that corresponds to a fluorescence image, and a normal picture image, such as shown in FIG. 4(b) that corresponds to a reflection image, are overlapped, can thereby be obtained." Namely, Applicants respectfully submit that, in the configuration of the invention disclosed in the instant application, the observation image, in which the fluorescence picture image and the normal picture image are overlapped, can be obtained as a single image by the single image pickup device, as described in above-described newly-amended independent claim 1 of the instant application.

In addition, with regard to the video signal, which is the image data of the observation image output from the image pickup device, it is described that, when "the optical filter, which transmits a portion of the reflection image, is used as described above, the normal picture image and the fluorescence picture image are mixed in the video signal" in paragraph [0043] of the specification of the instant application.

Accordingly, for at least the foregoing reasons, Applicants respectfully submit that newly-amended independent claim 1 fully complies with the requirements of 35 U.S.C. § 112, first paragraph. As a result, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 112, first paragraph.

Rejections under 35 U.S.C. § 103(a)

Claims 1-2 and 4-8 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hayashi in view of Sekiguchi. Applicants have newly-amended independent claim 1 to differently describe embodiments of the disclosure of the instant application and/or to improve the form of the claims. To the extent that these rejections might be deemed to still apply to the claims as newly-amended, the rejections are respectfully traversed for at least the following reasons.

Applicants respectfully submit that the configuration of the lymph node detecting apparatus of the present invention, including the above-described feature, is neither disclosed nor suggested in the cited documents of Hayashi and Sekiguchi.

Specifically, the Examiner states in the Office Action that Hayashi “teaches an observation unit comprises ... a photographing unit (image pick up means) [see 0080-84] and a monitor for displaying images [see 0100].”

In this regard, Applicants respectfully submit that, as to the photographing unit 220 shown in Fig. 5 of Hayashi, it is described in paragraph [0080] that the unit 220 photographs “the normal image, which is composed of reflected light of the white light, and fluorescent images composed of the near-infrared fluorescent light emitted from the area of tissue under examination upon irradiation thereof by stimulating light (emphasis added).”

On the other hand, Applicants respectfully submit that in the configuration of the present invention, a normal picture image, which is overlapped in the observation image output from the image pickup device, corresponds to the reflection image of the excitation light.

Further, Applicants respectfully submit that in the configuration of Hayashi, as clearly described in paragraph [0090] of Hayashi, "photographing of the normal image and photographing of the near-infrared fluorescent image are performed in a time division manner" (emphasis added)."

Namely, in Hayashi, photographing of the normal image and photographing of the fluorescent image are not simultaneously performed, and accordingly, the observation image, in which the fluorescence picture image and the normal picture image are overlapped, cannot be obtained as a single image by the single image pickup device in Hayashi, as described in newly-amended independent claim 1 of the instant application.

In addition, the Examiner states in the Office Action that Sekiguchi teaches visible radiation image and the fluorescent image are simultaneously displayed or overlapped on the display unit 41. However, Applicants respectfully submit that the above-described feature of the present invention is also not disclosed in Sekiguchi.

Specifically, Applicants respectfully submit that in the configuration shown in Fig. 1 of Sekiguchi, a white light source 7 and a laser 8 are provided for a optical guide fiber 2, and the incident end face 2a of the optical guide fiber 2 is positioned by an emission switching means which comprises a switch 9, such that the incident end face 2a faces the white light source 7 or the laser 8. Further, an image intensifier portion 10 comprises two light paths, a light path 15 for visible radiation images and a light path 16 for fluorescent images, the portion 10 further comprises shutters 21 and 22 for alternately opening and closing the light paths 15 and 16, and the shutters 21 and 22 and the shutter switch 23 constitute an incident light switching means for

inputting a visible radiation image and a fluorescent image one after the other into the television camera 12. In this regard, Applicants refer to Fig. 1 and column 3, lines 4 to 63 of Sekiguchi.

Thus, Applicants respectfully submit that also in the configuration of Sekiguchi including the switching means, the observation image, in which the fluorescence picture image and the normal picture image are overlapped, cannot be obtained as a single image by the single image pickup device.

Accordingly, Applicants respectfully assert that the rejections under 35 U.S.C. § 103(a) should be withdrawn because Hayashi and Sekiguchi, whether taken separately or combined, do not teach or suggest each feature of newly-amended independent claim 1 of the instant application. As pointed out by MPEP § 2143.03, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).” Since the prior art does not disclose or suggest any of the combinations recited in Applicants’ claims, and if anything appears to teach away from the current claim recitations, KSR Int’l Co. v. Teleflex Inc., 127 S.Ct. 1727 (2007), Applicants submit that such recited combinations would not have been obvious in view of the applied references of record, whether taken alone or combined in the manner suggested by the Examiner in the Office Action.

Furthermore, Applicants respectfully assert that the dependent claims 2 and 4-8 are allowable at least because of their dependence from independent claim 1, and the reasons discussed previously.


CONCLUSION

In view of the foregoing, Applicants submit that the pending claims are in condition for allowance, and respectfully request reconsideration and timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution. A favorable action is awaited.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Dated: February 16, 2011

Respectfully submitted,

By 
Paul A. Fournier
Registration No.: 41,023
DRINKER BIDDLE & REATH LLP
1500 K Street N.W.
Suite 1100
Washington, DC 20005-1209
(202) 842-8812
(202) 842-8465 (Fax)
Attorney For Applicants